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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,323	01/31/2002	Carl W. Gilbert	329.1001-U	9839

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EXAMINER

OH, TAYLOR V

ART UNIT PAPER NUMBER

1625

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/066,323	Applicant(s) GILBERT ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12,14,16,22,24,25 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 13,15,17-21,23 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12,14,16,22,24,25 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/21/05 has been entered.

The Status of Claims

Claims 1-12, 14, 16, 22, 24-25 and 31 are under consideration.

Claims 1-12, 14, 16, 22, 24-25 and 31 have been rejected.

Claims 13, 15, 17-21, 23, and 26-30 are withdrawn from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 14, 16, 22, 24-25 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 32, the phrase “each of which can be substituted” is recited.

The term “substituted” is indefinite. In the absence of the specific moieties intended to effectuate modification by the “substitution” or attachment to the chemical core claimed, the

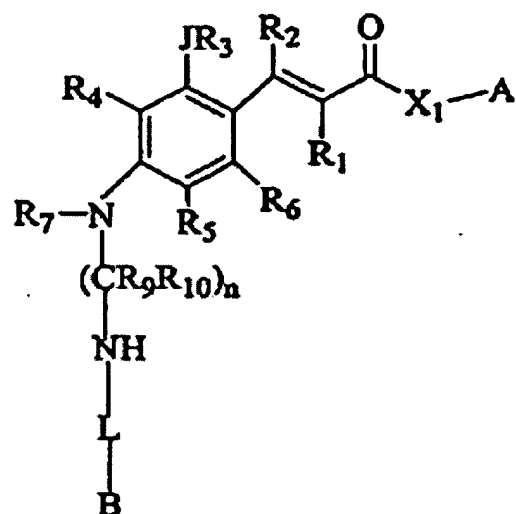
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term “substituted” renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed. Therefore , an appropriate correction is required.

In claim 1 , the phrase “L is a linker “ is recited. The expression is vague and indefinite because the term “ a linker “ is not defined in the compound claim. Therefore, an appropriate correction is required.

In claim 1 , the phrases “B is a first active moiety, reactive group moiety or a polymer” and “ A is a second active moiety” are recited. The expressions of “B” and “A” are vague and indefinite. There is no distinction between “a first active moiety “ and “a second active moiety” in view of an absent criteria. In the compound claim, the first active moiety and reactive group moiety have no meaning in terms of structural components in the formula; they need definite chemical structural formulas. Furthermore, the term “ a polymer” is unclear because “a polymer” is a compound that consists of very large molecules made up of many repeating subunits; there is uncertainty as to what the repeating subunit may be for the claimed compound. Therefore , an appropriate correction is required.

In claim 22, the following compound is disclosed:



• each of the groups “L” and “B” is vague

and indefinite because there are no concrete chemical formula for each group in the specification. The claimed compound needs clearly outlined boundary of the compound; otherwise, it becomes the compound without any limit, which can not be claimed in the patent.

In claim 31, the phrase “ L_1 is a moiety containing a functional group capable of reacting with the NHR_{22} ” is recited. The expression is vague and indefinite because L_1 is clearly not defined in the compound formula; L_1 needs to have a structural chemical formula in the compound claim. Therefore, an appropriate correction is required.

In claim 31, the phrases “ A is an active moiety”, “ L_1 is a moiety containing a functional group capable of reacting with the NHR_{22} ” and “ B_1 is polymers, biologically active materials and polymeric supports” are recited. The expressions of A , L_1 , and B_1 are vague and indefinite. In the compound claim, the second active moiety and the moiety containing the functional group have no meaning in terms of structural components in the formula; also, there are many functional groups which may not work with the NHR_{22} ; they need definite chemical

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structural formulas. Furthermore, the terms “ polymers, biologically active materials and polymeric supports” are unclear because there is uncertainty as to what each of polymers, biologically active materials and polymeric supports can be in the formula. “polymers” are compounds that consist of very large molecules made up of many repeating subunits; there is an uncertainty as to what the repeating subunit may be for the claimed compound. Therefore , an appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-2 , 10, 25 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Porter et al (US 5,218,137).

Porter et al discloses the following compounds :

(9) 2-Propenoic acid, 3-(2-hydroxy-4-diethylamino-phenyl)-2-methyl-4-(aminoiminomethyl)- phenyl ester, (E)-, monohydrochloride salt.

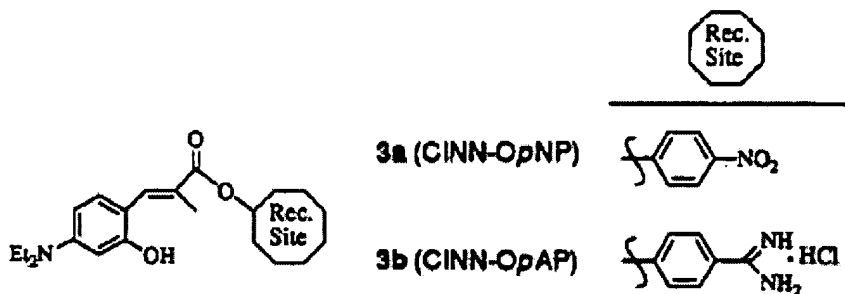
(see col. 5 ,lines 66-68); and 3-

[4-(diethylamino)-2-hydroxyphenyl]-2-methyl-2- propenoic acid (see col. 14 ,lines 49-50). This is identical with the claims.

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2. Claims 1-2, 10, 25 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Porter et al (J. Am. Chem. Soc. 1993, 115, p.9371-9379).

Porter et al discloses the following compounds (see page 9372, left col., line 23) :



This is identical with the claims.

Applicants' Argument

Applicants have argued the following issues:

- a. Applicants request that the examiner should rejoin those claims withdrawn previously from consideration in the application since the withdrawn claims are in the same scope with the allowable product claims.

The applicants' argument have been noted, but these arguments are not persuasive.

With regard to the applicants' argument, the Examiner has noted applicants argument. However, the original restriction was made by another examiner. Furthermore, he did not add any rejoinder statement in his restriction from the beginning. Moreover, there were five different inventions according to the original restriction; also, various classes and subclasses are

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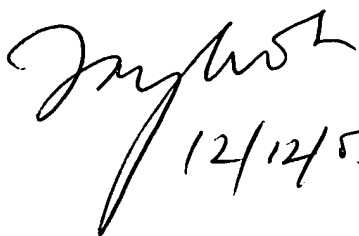
presented in the application. Regardless of being the allowable product claims in the same scope with the withdrawn claims, the withdrawn claims have been restricted out properly.

Furthermore, M.P.E.P. Section 808.02 gives legitimate reasons for the Examiner to insist on restriction such as the case of a separate invention, which indicates that "each distinct subject has attained recognition in the art as a separate subject for the inventive effort, and also a separate field of search."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


12/12/05